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| 10/817,545 | 04/02/2004 | William Jackson Devlin SR. | DCS-9166 | 2540 |
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| DADE BEHRING INC. LEGAL DEPARTMENT 1717 DEERFIELD ROAD DEERFIELD, IL 60015 | | | EXAMINER AKRAM, IMRAN | |
| | | | ART UNIT 1795 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,545

Applicant(s)

DEVLIN, WILLIAM JACKSON

Examiner

Imran Akram

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-5 in the reply filed on 10/25/07 is acknowledged.

Response to Arguments

2. Regarding claim 1, Applicant defines "the term 'server' to be the combination of either reagent container shuttle 27S or 28S and either reagent storage area 27 or 28 and either reagent container tray 27T or 28T, respectively" (paragraph 26 of specification). Applicant then argues in Remarks filed 10/25/07 that Bell fails to disclose two reagents servers because Bell discloses only one single reactant wheel 26. The examiner respectfully disagrees. Bell indeed discloses a "reagent container shuttle" 30, a "reagent storage area" 16, and a "reagent container tray" 20, as well as another reagent container shuttle 46, a reagent storage area 28, and a reagent storage tray 26. Consequently, two servers are disclosed.

3. In response to applicant's arguments over the obviousness of Bell in regards to claims 2-4, applicant states that Bell fails to make obvious a method of "placing assays into first and second different completion-time patterns, adding a second source of those reagents required to conduct assays in the first pattern of assays, where the first pattern has a larger portion of a first group of assays and a smaller portion of a second group of assays and wherein the second pattern has a larger portion of the second group of assays and a smaller portion of the

first group of assays" (page 8 of Remarks). Examiner respectfully disagrees. Bell teaches a first and second time-completion patterns (column 9, lines 53-58 of Bell). What is obvious is the sizes of the assays and, as the rejection stands below, this would be obvious in light of the quantities and types of assays being used.

4. Bell may "have been silent regarding distinct patterns of assays or about the size of groups," (page 8 of the arguments) but the rejection is one of obviousness-type and not an anticipatory rejection. Applicant's statement that "Bell would not have been silent regarding distinct patterns of assays or about the size of groups" is a conjecture about a different inventor's intentions and impermissible as an argument. Bell anticipates claim 1 and the rejection of claims 2-4 remain as stated below.

5. Applicant's arguments that Bell does not disclose "selecting reagents from whichever of the two (reagent) servers has the shorter backlog of demand with which to perform assays in the first pattern of assays" with respect to claim 5 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bell (US 5,679,309).
8. Regarding claim 1, Bell discloses a method for increasing the throughput of a clinical analyzer adapted to perform a number of different assays using reagents inventoried in at least two servers (combination of **30**, **16**, and **20** and **46**, **28**, and **26**), wherein a first pattern of assays is to be performed in a first time period and a different second pattern of assays is to be performed in a different second time period, the method comprising duplicating reagents required to conduct a number of assays in the first pattern of assays within the at least two servers (column 9, lines 35-67).
9. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Devlin (US 7,101,715 B2).
10. Regarding claim 1, Devlin discloses a method for increasing throughput of a clinical analyzer adapted to perform a number of different assays using reagents inventoried in at least two servers (column 3, line 63 to column 4, line 13), wherein a first pattern of assays is to be performed in a different second time period (column 5, line 63 to column 6, line 9); the method comprising duplicating reagents required to conduct a number of assays in the first pattern of assays within at least two servers (column 2, lines 19-30).
11. Regarding claim 2, Devlin discloses the first pattern of assays having a larger portion of a first group of assays and a smaller portion of a second group

of assays wherein the second pattern of assays has a larger portion of said second group of assays and a smaller portion of said first group of assays (paragraph 16).

12. Regarding claim 5, Devlin discloses selecting reagents from whichever of the at least two servers has the shorter backlog of demand with which to perform assays in the first pattern of assays (column 1, lines 46-63).

6. Claim 3 and 4 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Devlin (US 7,101,715 B2).

13. Regarding claim 3 and 4, Devlin discloses a rotatable reaction carousel **26** having cuvette ports **20** for supporting said assays, and each and every cuvette port being returned to an original position starting in said carousel in a full operational cycle time of the carousel (column 5, line 63 to column 6, line 9). It is inherent in the invention of Devlin that the first or second group of assays would be completed in less than half or more than half of the operational cycle time, respectively, because this would be dependent of the types of reactions and reagents used. Also, it would have been obvious to one having ordinary skill in the art at the time of invention for the operational cycle time of the first group of assays to be any fraction of time as compared to the second group because this would depend on the reagents used and the type of reactions occurring.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell as applied to claim 1 above.

17. Regarding claim 2, Bell is capable of performing multiple assays using the multiple servers found in Bell. What is not disclosed, however, is whether the first group of assays is larger or smaller than the second group of assays. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include any permutation of first and second group sizes as this choice would be dependent on the type of reagents used and the types of reactions performed.

18. Regarding claim 3, Bell discloses the analyzer comprising a rotatable reaction carousel having cuvette ports for supporting said assays, each and every cuvette port being returned to an original starting position in said carousel in a full operational cycle time of the carousel, and wherein said first group of assays comprise assays that are completed in less than one half of said operational cycle time (column 9, lines 35-52).

19. Regarding claim 4, Bell discloses said second group of assays comprising assays that require more than one half of said operational cycle time to be completed (column 9, lines 53-67).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Imran Akram whose telephone number is 571-270-3241. The examiner can normally be reached on 10-7 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on 571-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/817,545

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IA


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SUPERVISORY PATENT EXAMINER